IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

      Wasilewski, et al.

Serial No.: 10/602,986

Filed: June 25, 2003

Confirmation No.: 3781

Group Art Unit: 2131

Examiner: Chai, Longbit

Docket No.: A-9233 (191930-1560)

For: **Method for Partially Encrypting Program Data**

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

      Applicant submits the following remarks in support of a Request for a Pre-Appeal Brief

Conference.

REMARKS

Applicant submits that the following clear legal deficiency exists in the rejection.

Namely, the previous final Office Action equates "selectively encrypting packets and using a

PID to select packets for transmission" with "selecting for encryption a digital bit stream from a

plurality of digital bit streams using an identifier," which are two functions that are known to be

technically very different from each other. Additionally, the previous Office Action rejects the

claims under 35 U.S.C. 112. Applicant has supplied an affidavit from an expert in support of its

position that the claims are enabled.

I.   Objection to Specification and Rejection of Claims 1 and 13 under 35 U.S.C. 112

The specification is objected to as allegedly failing to provide proper antecedent basis for

the claim amendment filed 8/1/06. The Office Action rejects claims 1 and 13 under 35 U.S.C.

§112, First Paragraph, as allegedly failing to comply with the written description requirement.

Applicant respectfully submits that lines 19-28 on page 28 of provisional application 60/054,578

provide at least one embodiment of using a PID to select packets for encrypting. Line 19 discloses a

PID. Subsequently lines 23-26 state: "A subcategory of information can thus be identified by the

PID of its packets. As shown at output packets 707, the output from MUX 704 is a sequence of

individual packets from the subcategories. An part or all of MPEG-2 transport stream 701 may be

encrypted." See Provisional Application, lines 219-38. Applicant respectfully submits that claims 1

and 13 are enabled in this non-limiting embodiment. Additionally, Applicant has provided an

affidavit as attached by Howard Pinder, a co-inventor of the application, as evidence that the cited

paragraph supports claims 1 and 13. Therefore, Applicant respectfully submits that the rejection of

claims 1 and 13 should be withdrawn.

II.   Rejections of Independent Claim 1 Under 35 U.S.C. §102(e) and 102(a)

The Office Action rejects claim 1 under 35 U.S.C. §102(e) and 102(a) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent no. 5,359,601). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the '601 patent does not disclose, teach, or suggest at least **selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier**. Even if, assuming for the sake of argument, the '601 patent discloses that each type of stream is uniquely assigned a packet ID, the '601 patent fails to disclose selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier. The '601 patent fails to disclose how the packets are selected *for encryption*. If the Office Action is inferring that the '601 patent inherently uses the PID to select which packets are encrypted, Applicant respectfully submits that "[a]nticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference. ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In the '601 patent, the system could use some other method for selecting which packet to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. Therefore, it is neither necessary nor inherent to use a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream. Therefore, the '601 patent does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

III.   Rejections of Independent Claim 13 Under 35 U.S.C. §102(e) and 102(a)

The Office Action rejects claim 13 under 35 U.S.C. §102(e) and 102(a) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent no. 5,359,601). Applicant respectfully

submits that independent claim 1 is allowable for at least the reason that the '601 patent does not

disclose, teach, or suggest at least **selecting for encryption a program from a transport**

stream using an identifier. Even if, assuming for the sake of argument, the '601 patent

discloses that each type of stream is uniquely assigned a packet ID, the '601 patent fails to

disclose selecting for encryption a program from a transport stream using an identifier. The '601

patent fails to disclose how the packets are selected *for encryption*. If the Office Action is

inferring that the '601 patent inherently uses the PID to select which program is encrypted,

Applicant respectfully submits that "[a]nticipation by inherency requires that 1) the missing

descriptive matter be 'necessarily present' in the prior art reference. ..." *Continental Can Co. v.*

Monsanto Co., 948 F.2d 1264 (Fed. Cir. 1991). In the '601 patent, the system could use some

other method for selecting which program to encrypt. For instance, any program following an

audio program could be selected for encryption. Alternatively, every fourth program could be

selected for encryption. Therefore, it is not necessary, nor inherent to use an identifier to select

for encryption a program from a transport stream. Therefore, the '601 patent does not anticipate

independent claim 13, and the rejection should be withdrawn for at least that reason.

IV. Rejections of Independent Claim 1 Under 35 U.S.C. §102(b)

The Office Action rejects claim 1 under 35 U.S.C. §102(b) as allegedly being anticipated

by *Wasilewski, et al.* (U.S. Patent no. 5,418,782). Applicant respectfully submits that

independent claim 1 is allowable for at least the reason that the '782 patent does not disclose,

teach, or suggest at least **selecting for encryption a digital bit stream from a plurality of**

digital bit streams using an identifier. Even if, assuming for the sake of argument, the '782

patent discloses that each type of stream is uniquely assigned a packet ID, the '782 patent fails to

disclose selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier. The '782 patent fails to disclose how the packets are selected *for encryption*. If the Office Action is inferring that the '782 patent inherently uses the PID to select which packets are encrypted, Applicant respectfully submits that "[a]nticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference. ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In the '782 patent, the system could use some other method for selecting which packet to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. Therefore, it is not necessary, nor inherent to use a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream. Therefore, the '782 patent does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

V.   Rejections of Independent Claim 13 Under 35 U.S.C. §102(b)

The Office Action rejects claim 13 under 35 U.S.C. §102(e) and 102(a) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent no. 5,359,601). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the '601 patent does not disclose, teach, or suggest at least **selecting for encryption a program from a transport stream using an identifier**. Even if, assuming for the sake of argument, the '601 patent discloses that each type of stream is uniquely assigned a packet ID, the '601 patent fails to disclose selecting for encryption a program from a transport stream using an identifier. The '601 patent fails to disclose how the packets are selected *for encryption*. If the Office Action is inferring that the '601 patent inherently uses the PID to select which program is encrypted,

Applicant respectfully submits that "[a]nticipation by inherency requires that 1) the missing

descriptive matter be 'necessarily present' in the prior art reference ..." *Continental Can Co. v.*

Monsanto Co., 948 F.2d 1264 (Fed. Cir. 1991). In the '601 patent, the system could use some

other method for selecting which program to encrypt. For instance, any program following an

audio program could be selected for encryption. Alternatively, every fourth program could be

selected for encryption. Therefore, it is not necessary, nor inherent to use an identifier to select

for encryption a program from a transport stream. Therefore, the '601 patent does not anticipate

independent claim 13, and the rejection should be withdrawn for at least that reason.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the

re-opening of prosecution on the merits of the present application and all pending claims are

hereby courteously requested.

Respectfully submitted,

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& RISLEY, L.L.P.

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